



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,696	12/20/2001	Missy L. Villapudua	020375-003100US	4166

20350 7590 11/25/2003

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

WOO, RICHARD SUKYOON

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,696

Applicant(s)

VILLAPUDUA, MISSY L.

Examiner

Richard Woo

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

- 1) Applicant's arguments, filed on October 3, 2003, with respect to the rejections of claims under USC 102 or 103 have been fully considered and are persuasive. The previous rejections of all pending claims have been withdrawn.
- 2) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

- 3) Claims 1-2, 4-10, 13-14 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Flasherty et al. (US 2001/0011247 A1).

W.R.T. Claim 1:

O'Flasherty et al. discloses a method for protecting consumer personal data, comprising:

receiving an application for a payment instrument (e.g. credit card application, ATM card application), wherein the application comprises personal data and a privacy preference of a consumer (see Claim 1);

saving the application in a database; and

storing at least some of the personal data and the privacy preference onto the payment instrument (see Claims, and Fig. 6 and the description thereof).

W.R.T. Claims 2 and 4-10:

Art Unit: 3629

O'Flasherty et al. also discloses the method comprising:

wherein the payment instrument comprises a credit or debit card having a magnetic stripe, or a processor and memory (smart card) (see Claims and Figs.);

reading the personal data and the preference at a merchant location when the consumer's payment instrument is accessed, and saving the data at the merchant storage location (see [0039]-[0040], for example);

mailing marketing material to the consumer only if permitted by the consumer's privacy preference (see paragraph [0040] and claims);

wherein the privacy preference indicates that consumer receives marketing material only from affiliated merchants (*Id.*);

wherein the privacy preference indicates that consumer receives marketing material only from the affiliated bank (*Id.*); and

wherein the privacy preference indicates that the consumer opts out (see supra).

W.R.T. Claim 13:

O'Flasherty et al. discloses a method for protecting consumer personal data, comprising:

providing the consumer with a payment instrument (smart card, ATM, etc.) having stored thereon a privacy preference;

reading the privacy preference from the payment instrument when making a purchase at a merchant location (see generally claims and *supra*);

saving the application in a database (*Id.*); and

contacting the consumer in accordance with the privacy preference (see Fig. 1 and the description thereof).

W.R.T. Claims 14 and 16:

O'Flasherty et al. discloses the limitations of Claims 14 and 16 as applied to Claims 2 and 4-10 above.

Claim Rejections - 35 USC § 103

4) Claims 3 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Flasherty et al. in view of Pollin (US 5,727,249).

O'Flasherty et al. discloses the method for protecting consumer personal data as recited above, but does not specifically disclose that the payment instrument is a check.

Pollin teaches, for a system and method for protecting the consumer personal data, that the method comprises:

utilizing the check as the payment instrument; and
storing the secure information onto the printed MICR on the check.

Since Pollin and O'Flasherty et al. are both from the same field of endeavor, the purpose disclosed by Pollin would have been well recognized in the pertinent field of O'Flasherty et al..

Art Unit: 3629


Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art, to utilize the check as the well known payment instrument, as taught by Pollin, for the purpose of storing the preference data onto the check's printed MICR as well known payment instrument.

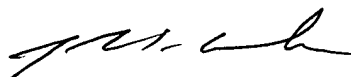
Conclusion

5) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.


Richard Woo
GAU 3629
November 14, 2003


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600